

AO 120 (Rev. 2/99)

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District California on the ☐ Patents or ☒ Trademarks:

DOCKET NO. CV 08-05416 JCS	DATE FILED 12/2/08	U.S. DISTRICT COURT 450 Golden Gate Avenue, 16 th Floor, Box 36060, SF CA 94102
PLAINTIFF SUN MICROSYSTEMS INC		DEFENDANT UNIX SURPLUS, ET AL
PATENT OR	DATE OF PATENT	HOLDER OF PATENT OR TRADEMARK
1 17 TH <i>pgs. 3-5</i>		*PLEASE SEE ATTACH COMPLAINT*
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In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Richard W. Wicking	(BY) DEPUTY CLERK Gina Augustine-Rivas	DATE December 2, 2008
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

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E-filing

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA – SAN FRANCISCO

SUN MICROSYSTEMS, INC.,

Plaintiff,

vs.

UNIX SURPLUS, an entity of unknown form;
JOHN BODO, an individual; AND DOES 1-10,
Defendants.

Case No.:

**COMPLAINT FOR INJUNCTIVE
RELIEF AND DAMAGES**

JURY TRIAL DEMANDED

I hereby certify that the annexed
instrument is a true and correct copy
of the original on file in my office.

ATTEST:

RICHARD W. WIRKING
Clerk, U.S. District Court
Northern District of California

By

Date

DEC 31 2008

1 Plaintiff SUN MICROSYSTEMS, INC. alleges as follows:

2 **JURISDICTION AND VENUE**

3 1. This case is an action for trademark infringement and false advertising under the
4 Lanham Act of 1946, 15 U.S.C. Sections 1051 *et seq.* (the "Lanham Act") and for related
5 accounting claims. This Court has jurisdiction over the subject matter of this action pursuant to
6 28 U.S.C. Section 1338 and under 28 U.S.C. Section 1331 because this case arises under the
7 trademark laws of the United States, 15 U.S.C. Sections 1051 *et seq.*

8 2. Venue is proper in the Northern District of California pursuant to 28 U.S.C.
9 Sections 1391 and 1400(a) because a substantial part of the events giving rise to this Complaint
10 and a substantial part of the property that is the subject of this action are situated in this District
11 and because Plaintiff is informed and believes, and on that basis alleges, that some or all of the
12 Defendants reside and/or have principal business offices in this District.

13 **INTRADISTRICT ASSIGNMENT**

14 3. This is an intellectual property action excepted from intra-district assignment
15 under Local Rule 3-2(c).

16 **PARTIES**

17 4. Plaintiff SUN MICROSYSTEMS, INC. ("SUN" or "Plaintiff") is a California
18 corporation with its principal place of business at Santa Clara, California.

19 5. Plaintiff is informed and believes, and on that basis alleges, that Defendant Unix
20 Surplus ("UNIX" or "Defendant") is an entity of unknown form, with its principal place of
21 business located at 691 Walsh Avenue, Santa Clara, California.

22 6. Plaintiff is also informed and believes, and on that basis alleges, that Defendant
23 John Bodo ("BODO" or "Defendant") is an individual who resides in the State of California.

24 7. Plaintiff is also informed and believes, and on that basis alleges, that BODO is
25 the principal of UNIX, and was the conscious, active and dominant force behind the unlawful
26 acts of UNIX as alleged in this Complaint.

27 8. Plaintiff is informed and believes, and on that basis alleges, that Defendants
28 DOES 1 through 10 are subject to the jurisdiction of this Court. Said Defendants, either alone or

1 through their agents, servants, and employees, are distributing, selling, and/or offering for sale
2 goods and merchandise which infringe, bear, displace and/or use, without authorization from
3 Plaintiff, one or more of Plaintiff's SUN TRADEMARKS, or conspired to do so. The identities
4 of the various individual and corporate Defendants are unknown to Plaintiff at this time.

5 9. Plaintiff is informed and believes, and on that basis alleges, that Defendants, and
6 each of them, are individuals or business entities acting either alone or in concert with the other
7 Defendants in committing the wrongful acts alleged herein.

8 **FACTUAL ALLEGATIONS**

9 **The Sun Trademarks**

10 10. Sun Microsystems was founded in 1982 and has for the past 26 years engaged in
11 the business of manufacturing and selling network computing infrastructure solutions that
12 include computer systems, software, storage and services.

13 11. Plaintiff's core brands include the Java technology platform, the Solaris operating
14 system, MySQL, StorageTek and the UltraSPARC processor. Attached hereto as Exhibit A is a
15 true and correct copy of an official SUN Corporate Overview, dated November 2008, available
16 at <<http://www.sun.com/aboutsun/media/presskits/SunCorporateBackgrounder.pdf>> (last
17 checked December 2, 2008).

18 12. The SUN brand has grown dramatically since its introduction in 1982 to an
19 international manufacturing, sales, and marketing company with over 30,000 employees
20 worldwide. Plaintiff strongly promotes its brand and its products through advertising, point of
21 sale materials, promotional materials, event sponsorships, and consumer electronics shows.
22 Plaintiff has developed a state of the art website located at <<http://www.sun.com/>> which
23 advertises, promotes and sells SUN products including software, servers, storage, desktop
24 solutions, microelectronics and more.

25 13. The SUN brand is well known among consumers of network computing
26 platforms. The SUN brand has received widespread acclaim from computing industry experts.
27 Attached as Exhibit B is the November 2008 issue of "*Good News from Sun Microsystems*" a
28 sampling of recent awards and commentary about SUN products, dated November 2008,

1 available at <http://www.sun.com/aboutsun/goodnews/pdfs/monthly_1108.pdf> (last checked
2 December 2, 2008).

3 14. Since its incorporation in 1982, Plaintiff has continuously used the name and
4 mark SUN MICROSYSTEMS in interstate commerce. On March 4, 1986, Plaintiff was issued a
5 federal registration for the mark SUN in class 9 for "Computer hardware . . . and Computer
6 software, namely, programs recorded on magnetic disks and tapes." On June 15, 1993, Plaintiff
7 was issued a federal registration for the mark SUN in Class 9 for "[c]omputers[] and computer
8 operating systems software and computer software for use in the field of computer networking
9" In addition to its exclusive rights to the name and mark SUN, Plaintiff owns federal
10 trademark and service mark registrations and/or common law rights on a host of SUN-
11 denominated marks (collectively, the "SUN TRADEMARKS"). Many of Plaintiff's federally
12 registered marks have achieved incontestable status within the meaning of 15 U.S.C. § 1065.

13 15. The SUN TRADEMARKS include, but are not limited to, the following twelve
14 incontestable U.S. Trademark Registrations for various types of computer hardware, computer
15 software, computer peripherals, and related goods and services:

- 16 • SUN—Registration No. 1776322; Application Date: 06/29/1992; Registration Date:
17 06/15/1993
 - 18 • SUN (and Logo)—Registration No. 1794747; Application Date: 06/29/1992;
19 Registration Date: 09/28/1993
 - 20 • SUN MICROSYSTEMS—Registration No. 1376942; Application Date: 05/04/1983;
21 Registration Date: 01/07/1986
 - 22 • SUN—Registration No. 1384991; Application Date: 05/24/1983; Registration Date:
23 03/04/1986
 - 24 • SUNLINK—Registration No. 1513411; Application Date: 10/05/1987; Registration
25 Date: 11/22/1988
 - 26 • SUN SITE—Registration No. 1938422; Application Date: 11/14/1994; Registration
27 Date: 11/28/1995
- 28

- 1 • SUNSPECTRUM—Registration No. 1867206; Application Date: 04/29/1993;
2 Registration Date: 12/13/1994
- 3 • SUN MICROSYSTEMS—Registration No. 2368045; Application Date: 02/22/1999;
4 Registration Date: 07/18/2000
- 5 • SUN MICROSYSTEMS (and Logo)—Registration No. 2497599; Application Date:
6 09/15/1999; Registration Date: 10/16/2001
- 7 • SUN RAY—Registration No. 2530320; Application Date: 04/30/1999; Registration
8 Date: 01/15/2002
- 9 • SUNSTART—Registration No. 1731627; Application Date: 06/14/1990; Registration
10 Date: 11/10/1992
- 11 • SUN MICROSYSTEMS (and Logo)—Registration No. 2463402; Application Date:
12 09/15/1999; Registration Date: 06/26/2001

13 16. These incontestable SUN TRADEMARKS are entitled to deference and special
14 privileges. Third parties may not claim that these SUN TRADEMARKS were improperly
15 registered or challenge SUN's ownership. Third parties also lose the right to assert the
16 affirmative defense that the SUN TRADEMARKS are merely descriptive of goods or services.
17 See 15 U.S.C. Section 1065.

18 17. The SUN TRADEMARKS also include U.S. Trademark Registrations for
19 pleaded marks covering various types of computer hardware, computer software, computer
20 peripherals, and related goods and services, including, but not limited to the following:

- 21 • SUN STOREEDGE—Registration No. 2679289; Application Date: 01/28/1998;
22 Registration Date: 01/28/2003
- 23 • MY SUN—Registration No. 2653106; Application Date: 11/05/1999; Registration
24 Date: 11/26/2002
- 25 • SUNTONE—Registration No. 2663626; Application Date: 04/08/1999; Registration
26 Date: 12/17/2002
- 27 • SUNTONE—Registration No. 2672493; Application Date: 04/08/1999; Registration
28 Date: 01/07/2003

- SUN CERTIFIED (and Design)—Registration No. 3228271; Application Date: 01/06/2000; Registration Date: 04/10/2007

18. Plaintiff is currently and at all relevant times has been the sole proprietor of all right, title and interest to the SUN TRADEMARKS, and has manufactured, sold and distributed the SUN TRADEMARKS in strict conformity with the provisions of the Lanham Act and all other laws governing trademarks.

19. Plaintiff has used the SUN TRADEMARKS in connection with the manufacture and marketing of various items of computing equipment, including but not limited to, server systems and various other similar items, and all copies of the SUN TRADEMARKS made by Plaintiff or under its authority or license have been made in strict conformity with the provisions of the Lanham Act and all other laws governing trademarks. Plaintiff has used the SUN TRADEMARKS on and in connection with its products on a continuous and regular basis throughout the entire United States and in many foreign countries.

20. Plaintiff and its licensees have spent substantial time and money to advertise, publicize, and promote the sale of products bearing the SUN TRADEMARKS throughout the United States and the world. Plaintiff and its licensees have sold many millions of dollars worth of products bearing the SUN TRADEMARKS throughout the world, including the United States and this judicial district.

21. Plaintiff has used many of the SUN TRADEMARKS, among other things, to denote its computer hardware, software and network-related products and services. SUN's name and the SUN TRADEMARKS have been promoted extensively by Plaintiff and enjoy widespread recognition. As a result, SUN's name and the SUN TRADEMARKS have become well known among consumers and users of computer systems, software and related services as identifying designations for SUN's products and services. Plaintiff has developed substantial goodwill in its name and in the SUN TRADEMARKS.

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1 Defendants' Knowing and Willful Copying and Infringement of Plaintiff's Trademark

2 22. The UNIX website, <<http://unixsurplus.zoovy.com/>>, states: "We specialize [sic]
3 in custom configured Sun Microsystems servers." A true and correct copy of the UNIX
4 homepage, printed on November 25, 2008, is attached to this Complaint as Exhibit C.

5 23. The UNIX website prominently features the SUN TRADEMARKS and
6 advertises multiple SUN products for sale, including, on the date visited, the SUN "Sparc 5" and
7 several "Sun Ultra" versions.

8 24. Plaintiff is informed and believes, and on that basis alleges, that Defendants, and
9 each of them, offer products bearing the SUN TRADEMARKS, including but not limited to the
10 products described herein, at other retail establishments in the United States and eBay.

11 25. Plaintiff is informed and believes, and on that basis alleges, that Defendants, and
12 each of them, knowingly and willfully directly copied some or all of the SUN TRADEMARKS
13 in their entirety. Plaintiff is further informed and believes, and on that basis alleges, that
14 Defendants, and each of them, copied some or all of the SUN TRADEMARKS for the specific
15 purpose of infringing Plaintiff's trademarks to aid in selling illegal, unauthorized and counterfeit
16 copies of products purportedly manufactured by SUN.

17 26. Plaintiff is informed and believes, and on that basis alleges, that long after
18 Plaintiff created the SUN TRADEMARKS, Defendants began to manufacture, distribute, and
19 sell various products that bear direct copies of the SUN TRADEMARKS.

20 27. Plaintiff is informed and believes, and on that basis alleges, that Defendants are
21 attempting to pass their products off as if they are SUN products in a manner calculated to
22 deceive Plaintiff's customers and members of the general public, in that Defendants have
23 directly copied the images of the SUN TRADEMARKS in an effort to make Defendants'
24 infringing counterfeit products confusingly similar to Plaintiff's products, and in that they have
25 modified the SUN products using non-SUN components that they are then attempting to pass off
26 as SUN products.

27 28. The natural, probable and foreseeable result of Defendants' wrongful conduct has
28 been, and will continue to be, to deprive Plaintiff of the benefits of using the SUN

1 TRADEMARKS, to deprive Plaintiff of goodwill, and to injure Plaintiff's relations with present
2 and prospective customers.

3 29. Plaintiff is informed and believes, and on that basis alleges, that it has lost and
4 will continue to lose substantial revenues from the sale of products bearing the SUN
5 TRADEMARKS and other products and will sustain damages as a result of Defendants'
6 wrongful conduct and production and sale of infringing counterfeit products. Defendants'
7 wrongful conduct has also deprived and will continue to deprive Plaintiff of opportunities for
8 maintaining and expanding its goodwill.

9 30. Plaintiff is informed and believes, and on that basis alleges, that unless enjoined
10 by this Court, Defendants intend to continue their course of conduct and to wrongfully use,
11 infringe upon, counterfeit, falsely advertise, sell and otherwise profit from the SUN
12 TRADEMARKS and works derived from them. As a direct and proximate result of the acts of
13 Defendants alleged above, Plaintiff has already suffered irreparable damage and has sustained
14 lost profits. Plaintiff has no adequate remedy at law to redress all of the injuries that Defendants
15 have caused and intend to cause by their conduct. Plaintiff will continue to suffer irreparable
16 injury and damage and sustain lost profits until Defendants' actions alleged above are enjoined
17 by this Court.

18 **FIRST CLAIM FOR RELIEF**

19 **Trademark Infringement – Section 1114 of the Lanham Act**

20 (Against All Defendants)

21 31. Plaintiff incorporates herein and realleges, as if fully set forth in this paragraph,
22 the allegations contained in Paragraph Nos. 1 through 30 above.

23 32. Plaintiff has built up valuable goodwill in the SUN TRADEMARKS and goods
24 bearing the SUN TRADEMARKS.

25 33. Defendants, with full knowledge of the notoriety of the SUN TRADEMARKS,
26 intended to and did trade on the goodwill associated with the trademarks, and have misled and
27 will continue to mislead the public into assuming a connection between the goods of Plaintiff
28

1 and Defendants through the sale and distribution of products which bear the registered SUN
2 TRADEMARKS.

3 34. By their actions alleged above, Defendants have infringed and will continue to
4 infringe the SUN TRADEMARKS by counterfeiting and selling products which purport to be,
5 but are not, SUN products.

6 35. Plaintiff is entitled to an injunction restraining Defendants, their officers, agents
7 and employees, and all persons acting in concert with them, from engaging in any further such
8 acts in violation of the trademark laws.

9 36. Plaintiff is further entitled to recover from Defendants the damages, including
10 attorneys' fees, it has sustained and will sustain, and any gains, profits and advantages obtained
11 by Defendants as a result of Defendants' acts of infringement alleged above. At present, the
12 amount of such damages, gains, profits and advantages cannot be fully ascertained by Plaintiff.

13 **SECOND CLAIM FOR RELIEF**

14 **False Advertising – Section 1125(a) of the Lanham Act**

15 (Against All Defendants)

16 37. Plaintiff incorporates herein and realleges, as if fully set forth in this paragraph,
17 the allegations contained in Paragraph Nos. 1 through 36 above.

18 38. Defendants have used in commerce words, terms, names, symbols, devices,
19 combinations and/or false or misleading designations of origin, false or misleading descriptions
20 of fact, and/or false or misleading representations of fact, which: (a) are likely to cause
21 confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of
22 UNIX with SUN and/or the SUN TRADEMARKS, or as to the origin, sponsorship, or approval
23 of SUN goods, services and/or commercial activities by Defendants; and/or (b) in commercial
24 advertising or promotion, misrepresent the nature, characteristics, or qualities of SUN goods,
25 services or commercial activities.

26 39. Defendants' acts are in violation of 15 U.S.C. Section 1125(a) and Plaintiff has
27 been and is likely to be damaged by these acts.
28

1 **THIRD CLAIM FOR RELIEF**

2 **Accounting**

3 (Against All Defendants)

4 40. Plaintiff incorporates herein and realleges, as if fully set forth in this paragraph,
5 the allegations of Paragraph Nos. 1 through 39 above.

6 41. Defendants' infringement of the SUN TRADEMARKS, and Defendants' sale and
7 distribution of infringing products in the United States without authorization has benefited and
8 continues to benefit Defendants.

9 42. As a result, Defendants owe Plaintiff restitution and disgorgement of profits, if
10 any, of an amount unknown to Plaintiff, and which amount cannot be ascertained without an
11 accounting of the receipts and disbursements, profit and loss statements, and other financial
12 materials, statements and books from Defendants.

13 43. Plaintiff is therefore entitled to an accounting of Defendants' records.

14 **PRAYER FOR RELIEF**

15 WHEREFORE, by virtue of the unlawful conduct of Defendants as alleged in this
16 Complaint, Plaintiff respectfully prays:

17 1. On the First and Second Claims for Relief:

- 18 a. That the Court issue a temporary restraining order, a preliminary injunction, and
19 thereafter a permanent injunction enjoining Defendants, their officers, directors,
20 principals, agents, servants, employees, successors and assigns, and all those
21 persons in active concert or participation with them, from:
- 22 (1) imitating, copying or making unauthorized use of the SUN TRADEMARKS;
 - 23 (2) manufacturing, printing, producing, distributing, circulating, selling, offering
24 for sale, advertising, promoting or displaying any product bearing any
25 simulation, reproduction, counterfeit, copy or colorable imitation of the SUN
26 TRADEMARKS; and
 - 27 (3) using any simulation, reproduction, counterfeit, copy or colorable imitation
28 of the SUN TRADEMARKS, in connection with the promotion,

1 advertisement, display, sale, offering for sale, manufacture, printing,
2 production, circulation or distribution of any product.

- 3 b. That judgment be entered for Plaintiff and against Defendants for Plaintiff's
4 actual damages arising from Defendants' infringement of the SUN
5 TRADEMARKS, plus any profits attributable to infringements of Plaintiff's
6 trademarks, according to proof at trial.
- 7 c. That judgment be entered for Plaintiff and against Defendants for statutory
8 damages pursuant to the trademark statutes.
- 9 d. That Defendants be required to recall from all distributors, wholesalers, jobbers,
10 dealers, retailers, brokers and all others known to Defendants, any originals,
11 copies, facsimiles or duplicates of any product shown by the evidence to infringe
12 the SUN TRADEMARKS.
- 13 e. That Defendants be required to deliver up to be impounded during the pendency
14 of this action all copies of the SUN TRADEMARKS in Defendants' possession
15 or under Defendants' control, including all products, labels, signs, prints,
16 packages, dies, wrappers, receptacles and advertisements in Defendants'
17 possession or under their control, bearing any of Plaintiffs' trademarked material,
18 including the SUN TRADEMARKS or any simulation, reproduction, counterfeit,
19 copy or colorable imitation thereof, including without limitation webpages, and
20 all plates, molds, matrices, masters, tapes, films, negatives or other articles by
21 means of which such copies may be reproduced.

22 2. On all Claims for Relief:

- 23 a. Pre-judgment and post-judgment interest as allowed by law;
24 b. Attorneys' fees and the costs of this action, as allowed by law; and
25 c. Such other and further relief as the Court may deem just and proper.
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1 DATED: December 2, 2008.

2 HOGAN & HARTSON, L.L.P.

3
4 By Megan Dixon
5 MEGAN DIXON
6 Attorneys for Plaintiff
7 SUN MICROSYSTEMS
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DATED: December 2, 2008.

By Megan Dixon
MEGAN DIXON
Attorneys for Plaintiff
SUN MICROSYSTEMS